Docket No.: MED-01105/29 (PATENT)

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Michael A. Masini

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| Application No.: 10/685,620 | Confirmation No.: 5102 |
| Filed: October 15, 2003 | Art Unit: 3738 |
| For: BONE-CONSERVING ORTHOPEDIC INSTRUMENTATION AND APPLIANCES | Examiner: B. E. Snow |

## REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is being submitted to address new issues raised by the Examiner in the Examiner's Answer mailed February 2, 2007.

### Section A

On page 5 of the Examiner's Answer, the Examiner advances the new argument that the apparatus of Johnson et al. (U.S. Patent No. 5,980,526) "is capable of being positioned on the lateral side or somewhere in between as deemed necessary." Indeed, the Examiner contends that the apparatus of Johnson et al. "is fully capable of being positioned vertically." Apart from providing no evidence as to how this could be accomplished, the Examiner is using objections to functional language to disregard structural limitations.

Claim 1 includes "first and second saw-receiving slots, each being associated with a respective one of the lateral and medial resections." The resections resulting therefrom slope inwardly along different planes from a respective outer medial and lateral surface. This apparatus is shown in Figure 6B of Appellant's specification. Appellant's cutting guide does not have to be removed and rearranged to meet the limitations of the claim. In contrast, as far as Appellant can ascertain, if the apparatus of Johnson et al. were continuously and systematically removed and repositioned in a manner not taught by the '526 patent, the resections desired by Appellant could somehow be achieved. The fact remains, however, that the apparatus of Johnson et al. neither teaches nor suggests a body already having first and second saw-receiving slots, each associated with a respective one of the lateral and medial resections, such that the resections made with the body result in resections that slope inwardly along different planes. The Examiner has failed to provide evidence as to where these structural limitations are met by the cited reference, such that *prima facie* anticipation has not been established.

With regard to the rejection over Whiteside et al., the Examiner poses the question "how can the device be fitted to the femur before its reduction?" That's not the point. Appellant's argument is that once it is placed in intimate contact on the distal end of the femur, it cannot be "tilted while cutting," as suggested by the Examiner, to fulfill the requirements of Appellant's claims. The Examiner's new argument that "Note that the device of Whiteside et al. is very similar to applicant's device shown in Figure 1," should just simply be disregarded. Any visual similarities are irrelevant, in that Appellant is not claiming the ornamental features of the apparatus; in other words, this is not a design patent application.

The Examiner's argument that "None of the claims preclude the device being positioned for a first resection and being repositioned for a second resection" is incorrect. Claim 1 includes "first and second saw-receiving slots, each being associated with a respective one of the lateral and medial resections." This limitation, alone, is not found in Johnson et al. or Whiteside. Further, given these existing slots on a cutting guide body, the resections resulting therefrom slope inwardly along different planes for a respective outer medial and lateral surface. This, too, is neither taught nor suggested by the prior art.

## Section B

Regarding claims 7, 15, 22 and 23, the Examiner now states for the first time during prosecution of this application, that the structural limitation of claim 8 refers to "the wedge shaped bone which has been removed." This makes no sense. First, why would one remove a piece of bone only to put it back? Secondly, the pieces of bone removed during such procedures are not wedge shaped; rather, they have one flat side created by the saw or osteotome, with the other surfaces being rounded, defective or otherwise incapable of geometric description. Appellant's claims clearly define over this "interpretation." With regard to the rejection over Whiteside, given that this is a rejection under 35 U.S.C. §102(b), and that the Examiner's arguments did not make sense to Appellant, it is virtually impossible to make any arguments in rebuttal. The Examiner cites "at least column 3, line 38" of Whiteside, which reads "the correct size for applying a prosthesis to be used in the." The Examiner makes the further "argument" "Regarding the wedge-shaped augments, see elements 77." Elements 77 are L-shaped, and not wedge-shaped. Thus, *prima facie* anticipation has not been established.

Section C

The Examiner makes the argument that the device of Johnson et al. "can be manipulated by hand tilting to get the claimed resection." Again, the Examiner is attempting to argue that Appellant's claim has *only* functional language when, in fact, it has structural limitations which are being disregarded. Claim 9 includes the limitations of the cutting guide having first and second saw-receiving slots, the first slot being substantially conformal to one of the protrusions on a condyle, with the other being substantially conformal to the side wall of another protrusion, such that the resections resulting therefrom do not lie in the same plane. Assuming that Appellant's apparatus is novel and not obvious, according to the rules of the Examiner, there would be no way for Appellant to claim it. Since by the Examiner's logic, just about anything with a flat surface could be "manipulated by hand" to achieve a cut in any plane of any material, to create any surface. It is curious why the Examiner even resorts to prior art in the orthopedic field.

Section D

Regarding 17, the Examiner's new argument is that "one having ordinary skill in the art should recognize stem 64 and slots 100 and 110" of Johnson et al. Yes, one of ordinary skill in the art can see these items in the issued patent, and can read about them in the specification. However, one of ordinary skill in the art would not recognize that such items are "fully capable" of being used as claimed wherein stem 64 is insertable into the bone in substantial alignment. "It is the Examiner's position the devices of Johnson et al. and Whiteside et al. teach all the positively claimed elements and are fully capable of fulfilling the claimed functional language." Item 64 of

Johnson et al. is *a guide pin*. Johnson et al. describe, at length, the purpose for this guide pin, and how it is used. "With the guide pin 64 firmly embedded in the tibia as shown in Figure 7, proximal end portion 66 of the guide pin 64 is received through holes 118, 124 so that the proximal end 68 of the guide pin 64 abuts the surface 124 of the flange 122." ('526 patent 6:41-45). This is only a small part of the disclosure of Johnson et al. relating to the use of the guide pin 64. Nevertheless, the Examiner contends that it would be apparent to "one having ordinary skill in the art" that "stem 64 is insertable into the bone in substantial alignment [with the longitudinal axis]" (as claimed by Appellant). The prior art neither teaches nor suggests how this would be accomplished if, indeed, it is possible at all.

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Respectfully submitted,

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